

REMARKS

Claims 1-18 are currently pending in the present application. Claim 5 has been amended. Support for the amendment may be found on pages 6-8 and FIG. 1 of the specification. No new matter has been added. Reexamination and reconsideration of the application are respectfully requested.

REJECTION OF CLAIMS 5-7 UNDER 35 U.S.C. 102(e)

Claims 5-7 are rejected under 35 U.S.C. 102(e) for the reasons set forth on pages 2-3 of the Action. Specifically, claims 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Young No (U.S. Pat. No. 6,587,140, hereinafter referred to as "No" or "the No reference").

The rejections under 35 U.S.C. 102(e) are respectfully traversed, at least insofar as applied to the amended claim, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth herein below.

FIG. 1 and FIG. 2, elements 5, 50, 83, 76, and 92, and Column 4, lines 38-45, of the No reference are cited as teaching the office machine as claimed. It is respectfully submitted that the No reference fails to teach or suggest the office machine as claimed.

Specifically, the No reference fails to teach or suggest inter alia the following claim limitations: "laser print engine for rendering images," as claimed in claim 5. For example, No describes printing unit 44 as a "thermal printing unit" (see col. 3, lines 47-59), whose operation and construction are different from a laser print engine. Also, the Action points to the CPU 92 as teaching the printer formatter as claimed. However, it

is respectfully submitted that processor 92 of No is very different in construction, operation and function than the printer formatter as claimed.

For example, CPU 92 of Tsukamoto is described as performing the following functions: 1) implementing the JPEG compression algorithm (col. 4, lines 35-37), and 2) converting data stream received from imaging unit 33 into printer instructions (col. 4, lines 40-42). In contrast, the printer formatter performs formatting functions that support the laser print engine.

Furthermore, one aspect of the invention is to provide a system that allows the user to be able to easily access, configure, and upgrade the formatter. Unfortunately, this is not possible with prior art printer system configurations. (see Background section of application). This aspect is neither taught nor suggested by the No reference.

In view of the foregoing, it is respectfully submitted that the No reference, whether alone or in combination, fails to teach or suggest the office machine as claimed. Accordingly, it is respectfully requested that the claim rejections under 35 U.S.C. Section 102(e) be withdrawn.

REJECTION OF CLAIMS 1, 16-18 UNDER 35 U.S.C. 103(a)

Claims 1, 16-18 are rejected under 35 U.S.C. 103(a) for the reasons set forth on pages 4-5 of the Action. Specifically, claims 1, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (U.S. Pat. No. 6,801,328, hereinafter referred to as "Tsukamoto" or "the Tsukamoto reference") in view of Young No (U.S. Pat. No. 6,587,140).

The rejections under 35 U.S.C. 103(a) are respectfully traversed, at least insofar as applied to the amended claim, and reconsideration and reexamination of the application are respectfully requested for the reasons set forth herein below.

The Action cites recording portion 110 as teaching the laser print engine as claimed. However, it is respectfully submitted that recording portion 110 is very different from the laser print engine as claimed.

Tsukamoto states, "The recording portion 110 comprises a DMA controller, a general-purpose IC and a thermal head or an ink jet head, the recording portion 110 being arranged to sequentially take data stored in the RAM 103 under control of the CPU 101 to print out it on B4 or A4 recording paper as a hard copy."

It is respectfully submitted that the construction and operation of a laser print engine is different from the construction and operation of a thermal head or ink-jet head.

Furthermore, as noted by the Action, Tsukamoto does not teach a formatter IC in the PC card as claimed. The card 7 of the No reference is then cited to teaching the PC card as claimed. It is respectfully submitted that card 7 of the No reference does not fairly teach or suggest the PC card as claimed as advanced previously. For example, FIG. 14 of Tsukamoto (e.g., steps S701 to S713) does not fairly teach or suggest formatting functions performed by the formatter IC.

Furthermore, Tsukamoto teaches away from the combination proposed by the Action since FIG. 15 and the corresponding description of the printer interface card 116 in Tsukamoto illustrate that card 116 is simply a buffer for signals (e.g., D0-D7, PE,

Strobe, and Busy) between the PCMCIA portion 114 and a Centronics connector. For example, Tsukamoto states:

The printer interface card 116 has a shape and pin configuration conforming to Type-2 of PCMCIA. 8-bit parallel data D0 to D7 to be recorded is transferred through data input/output pins of the printer interface card 116. Signals PE, for notifying the personal computer of the presence/absence of recording paper, BUSY, for notifying the personal computer of a busy state, and STROBE, transmitted from the personal computer, are signals that are out of the PCMCIA regulation. Therefore, the foregoing signals are transferred through the upper three bit input/output pins for address signals. The connection with the personal computer is established through a Centronics.RTM. connector (Centronics is a registered trademark of Genicom).

This description of Tsukamoto clearly indicates that card 116 is simply an interface (i.e., a buffer) without a formatter integrated circuit. In fact, Tsukamoto teaches a card 116 without any type of processing circuit. Instead, the processor (CPU 101) in Tsukamoto's apparatus is disposed in the fax machine.

Moreover, the cited references do not fairly teach or suggest the provision of a printer formatter external to the printer enclosure for efficient and user-friendly replacement, upgrade, configuration, etc., which was not the case before the present invention.

In view of the foregoing, it is respectfully submitted that the Tsukamoto reference, whether alone or in combination with the No reference, fails to teach or suggest the invention as claimed. Accordingly, it is respectfully requested that the claim rejections under 35 U.S.C. Section 103(a) be withdrawn.

Claims 2-4, 10-14 are rejected under 35 U.S.C. 103(a) for the reasons set forth on pages 5-8 of the Action. Specifically, claims 2-4, 10-14 are rejected under 35 U.S.C.

103(a) as being unpatentable over Tsukamoto et al. (U.S. Pat. No. 6,801,328, hereinafter referred to as "Tsukamoto" or "the Tsukamoto reference") and Young No (U.S. Pat. No. 6,587,140) and in view of Benjamin et al. (U.S. Pat. No. 6,113,208, hereinafter referred to as "Benjamin" or "the Benjamin reference").

The rejections under 35 U.S.C. 103(a) are respectfully traversed, and reconsideration and reexamination of the application are respectfully requested for the reasons set forth herein below.

Benjamin is cited for teaching an automatic update module that downloads a printer driver from a Website as claimed. Specifically, col. 3, lines 50-67 and col. 4, lines 1-40 are cited for this teaching. It is respectfully submitted that the combination of Tsukamoto and No fails to teach or suggest the invention as claimed for the same reasons as advanced previously. Benjamin does not cure the deficiencies of the Tsukamoto and No references.

In view of the foregoing, it is respectfully submitted that the Tsukamoto reference, whether alone or in combination with the No reference and the Benjamin reference, fails to teach or suggest the invention as claimed. Accordingly, it is respectfully requested that the claim rejections under 35 U.S.C. Section 103(a) be withdrawn.

Claims 15 is rejected under 35 U.S.C. 103(a) for the reasons set forth on page 7 of the Action. Specifically, claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto, No, Benjamin and further in view of Austin (U.S. Pat. No. 6,665,089, hereinafter referred to as "Austin" or "the Austin reference").

Austin is cited for teaching performing a cyclic redundancy check. Specifically, FIG. 18, col. 12, lines 60-67 and col. 13, lines 1-30 are cited for this teaching. It is respectfully submitted that the combination of Tsukamoto, No, and Benjamin fails to teach or suggest the invention as claimed for the same reasons as advanced previously. Austin does not cure the deficiencies of Tsukamoto, No and Benjamin.

In view of the foregoing, it is respectfully submitted that the Tsukamoto reference, whether alone or in combination with the No reference, Benjamin reference, and the Austin reference, fails to teach or suggest the claimed invention. Accordingly, it is respectfully requested that the claim rejections under 35 U.S.C. Section 103(a) be withdrawn.

THE PROPOSED COMBINATIONS ARE BASED ON IMPERMISSIBLE  
USE OF THE CLAIMED INVENTION AS A TEMPLATE TO PIECE TOGETHER  
THE TEACHINGS OF THE CITED REFERENCES

It is respectfully submitted that the references are improperly combined. It appears that the Action uses improper hindsight to select components or elements from the different references to arrive at the claimed invention.

Assuming arguendo that the different components of the different references may be combined in the manner outlined in the Action, the Federal Circuit has stated, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) [emphasis added].

The Federal Circuit has further held In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992):

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. ... “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art ... would lead that individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). [emphasis added.]

Consequently, it appears that the current patent application has been improperly used as a basis for the motivation to combine or modify the components selected from the cited references (e.g., Tsukamoto, No, Benjamin, and Austin) to arrive at the claimed invention. Stated differently, the proposed combination of the cited references appear to be based on hindsight since the cited references do not teach or suggest a motivation to combine the respective elements of each reference in the manner proposed by the Action.

The Federal Circuit has held, “It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)), In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992). [emphasis added.]

Furthermore, the Federal Circuit has held, “The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That

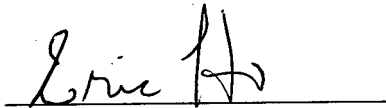
Appl. No.: 09/675,920  
Amdt. Dated March 14, 2005  
Reply to Office Action of Dec. 13, 2004

knowledge can not come from the applicant's invention itself." In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

Accordingly, hindsight reconstruction may not be used to pick a component from one reference and another component from another reference to arrive at the invention as claimed. Accordingly, it is respectfully requested that the rejections of claims 1, 2-4, 10-14, 15, and 16-18 under 35 U.S.C. 103(a) be withdrawn.

For all the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the pending claims are requested, and allowance is earnestly solicited at an early date. The Examiner is invited to telephone the undersigned if the Examiner has any suggestions, thoughts or comments, which might expedite the prosecution of this case.

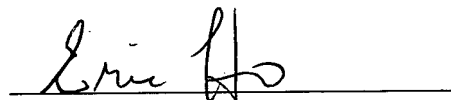
Respectfully submitted,



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Dated: March 14, 2005

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Eric Ho (RN 39,711)

March 14, 2005  
(Date)